



BD1 CIP FWC II DIV 1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Sherie L. Morrison, et al. #3098
Serial No. : 07/893,610 SU 9/24 GB
Filed : June 3, 1992
For : RECEPTORS BY DNA SPLICING
AND EXPRESSION
Group : 1806
Examiner : T. Nisbet

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

DECLARATION OF LEONARD A. HERZENBERG
PURSUANT TO 37 C.F.R. § 1.131

I, LEONARD A. HERZENBERG, declare that:

1. I am a co-inventor in the above-identified patent application.
2. I am aware of the following publication by Ochi et al., "Functional Immunoglobulin M Production After Transfection Of Cloned Immunoglobulin Heavy And Light Chain Genes Into Lymphoid Cells", Proc. Nat'l Acad. Sci. USA, vol. 80, pp. 6351-55 (Oct. 1983), and am informed and believe that it was mailed to subscribers of the journal in which it

was published on October 19, 1983. A copy of that article is attached hereto as Exhibit A.

3. I make this declaration to establish, when read in conjunction with the declarations of Sherie L. Morrison and Vernon T. Oi, my co-inventors, the conception of producing a functional antibody from a transfected mammalian cell prior to the October 19, 1983 effective date of the Ochi reference and to establish the diligent reduction to practice of the invention from a time prior to said date.

4. Conception of the invention is evidenced by the grant application that I submitted to Becton Dickinson with Vernon T. Oi and by the grant application that Sherie L. Morrison submitted to the American Cancer Society. The dates of those applications are prior to October 19, 1983. Copies of the pertinent portions of the applications are attached as Exhibit B and Exhibit C respectively.

5. Prior to October 19, 1983, Dr. Oi was employed in my laboratory at Stanford University as a post-Doctoral scientist. Dr. Oi and I had conceived the idea of producing chimeric antibodies and Dr. Oi was engaged in laboratory work under my supervision that resulted in the construction of a vector (designated HuK) containing a gene coding for the light chain of an antibody. Evidence of this work is contained in the copies of pages from Dr. Oi's

laboratory notebook attached hereto as Exhibit D. Those pages are dated prior to October 19, 1983. Dr. Oi also completed construction of a vector (designated HuG) containing a gene coding for the heavy chain of an antibody. Evidence of this work is contained in the copies of pages from the laboratory notebook of Tim Gadus, a technician in my laboratory with whom Dr. Oi worked, attached hereto as Exhibit E. Those pages are dated prior to October 19, 1983. These vectors contained regulatory sequences making them suitable for transfection into and expression in mammalian cell lines.

6. Prior to October 19, 1983 Dr. Oi accepted a job at Becton Dickinson and Company. Dr. Oi left my laboratory in November 1983.

7. I am informed and do believe that on November 23, 1983 the HuK and HuG vectors that Dr. Oi had constructed were sent to Dr. Morrison from my laboratory by Tim Gadus. These materials were typically sent via the United States Postal Service, regular mail. A copy of the transmittal record evidencing this shipment is attached hereto as Exhibit F.

8. I further declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge

that willful, false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or any patent issuing thereon.

By

Leonard A. Herzberg
Leonard A. Herzberg

Dated: *August* 6, 1993



PATENTS

REV. 1-93
Modified PTO
For Other ~~Small Entity~~ A Small Entity

Attorney Docket No. BD1 CIP FWC III

Applicant(s) : Sherie L. Morrison, et al.
Serial No. : 07/893,610
Filed : June 3, 1992
For : RECEPTORS BY DNA SPLICING
AND EXPRESSION
Group Art Unit : 1806
Examiner : T. Nisbet

August 23, 1993

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

TRANSMITTAL LETTER

Sir:

Transmitted herewith: [] a Preliminary Amendment; [X] a Response to Examiner's Action including Amendment; [] a Supplemental Amendment; [] a substitute Specification; [X] two Declarations; [] a Supplemental Declaration; [] a Power of Attorney; [] an Associate Power of Attorney; [] formal drawings; to be filed in the above-identified patent application.

FEE FOR ADDITIONAL CLAIMS

[] A fee for additional claims is not required.

[X] A fee for additional claims is required. The additional fee has been calculated as shown below:

CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEES
TOTAL CLAIMS 35	- 20	* = 15	X \$22	= \$330.00
INDEPENDENT CLAIMS 3	- 3	** = 0	X \$74	= \$ 0.00
FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM				+ \$230 = \$ 0.00

* If less than 20, insert 20.
** If less than 3, insert 3.

TOTAL \$330.00

A check in the amount of \$330.00 in payment of the filing fee is transmitted herewith.

The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 C.F.R. § 1.16, in connection with the paper(s) transmitted herewith, or credit any overpayment of same, to deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

Please charge \$_____ to Deposit Account No. 06-1075 in payment of the filing fee. A duplicate copy of this transmittal letter is transmitted herewith.

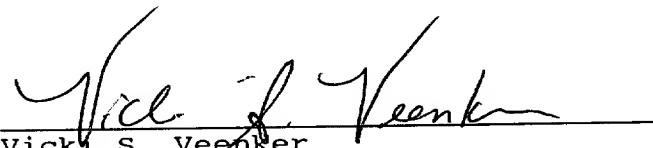
EXTENSION FEE

The following extension is applicable to the Response filed herewith; [] \$110.00 extension fee for response within first month pursuant to 37 C.F.R. § 1.17(a); \$360.00 extension fee for response within second month pursuant to 37 C.F.R. § 1.17(b); [] \$840.00 extension fee for response within third month pursuant to 37 C.F.R. § 1.17(c); [] \$1,320.00 extension fee for response within fourth month pursuant to 37 C.F.R. § 1.17(d).

A check in the amount of [] \$110.00; \$360.00; [] \$840.00; [] \$1,320.00; in payment of the extension fee is transmitted herewith.

The Commissioner is hereby authorized to charge payment of any additional fees required under 37 C.F.R. § 1.17 in connection with the paper(s) transmitted herewith, or to credit any overpayment of same, to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.

Please charge the [] \$110.00; [] \$360.00; [] \$840.00; [] \$1,320.00; extension fee to Deposit Account No. 06-1075. A duplicate copy of this transmittal letter is transmitted herewith.


Vicki S. Veenker
Registration No. 34,269
Attorney(s) for Applicant(s)

I Herby Certify that this Correspondence is being Deposited with the U. S. Postal Service as First Class Mail in an Envelope Addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on August 23, 1993

Dalene Quilachon-Rosen
Name of Person Signing

Dalene Quilachon-Rosen
Signature of Person Signing

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